

### **REMARKS**

In response to the Final Office Action mailed November 30, 2004, Applicant respectfully requests reconsideration. Claims 1-24 were previously pending in this application. Claims 1, 8, 9, 16 and 24 have been amended. New claims 25-27 have been added. As a result, claims 1-27 are pending for examination with claims 1, 9 and 16 being independent claims. No new matter has been added.

### **Claim Objections**

In paragraph 2 of the Office Action, claims 8 and 24 are objected to because of alleged informalities. The Office Action contends that in claim 8, the phrase "the opening" should be replaced with "an opening", and the word "it" should be replaced with "the adhesive rectangle." To further the prosecution of this application, Applicants have amended claim 8 as requested. The Office Action also contends that in claim 24, the label "(A)" should be removed because there is no act labeled "(B)". Applicants have otherwise amended claim 24, rendering this objection moot.

### **Rejections under 35 U.S.C. §102(e)**

Claims 1-3, 6-7, 16-18 and 21-23 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 5,708,419 to Isaacson et al. ("Isaacson"). Applicant respectfully traverses this rejection.

#### **A. Claims 1-8**

As amended, claim 1 recites a self-adhesive electronic circuit including a planar base having first and second base surfaces, an antenna attached on the first surface of the base, a chip connected to the antenna, and a double-faced adhesive glued on one of the base surfaces, the double-faced adhesive having an opening and the chip being arranged at least partially in the opening, wherein the double-faced adhesive has first and second adhesive surfaces, wherein the first adhesive surface is glued on one of the base surfaces, and wherein the second adhesive surface is covered by a protective cover which is removable to expose the second adhesive surface as an outward adhesive surface of the self-adhesive electronic circuit.

Isaacson fails to disclose or suggest the limitations of amended claim 1. For example, Isaacson fails to disclose or suggest a self-adhesive electronic circuit which includes a double-faced adhesive having a first adhesive surface which is glued on a base surface and a second adhesive surface which is covered by a protective cover that is removable to expose the second adhesive surface as an outward adhesive surface of the self-adhesive electronic circuit.

Claim 1 has been amended to clearly distinguish Isaacson. Isaacson discloses a tag structure designed to resemble a credit card (col. 10, line 10), which does not include a double-faced adhesive having a protective cover that is removable to expose the double-faced adhesive as an outward adhesive surface. The Office Action contends that in FIG. 8, Isaacson discloses a circuit that includes a double-faced adhesive having a first adhesive surface adhered to a base of the electronic circuit and a second adhesive surface (i.e., the surface which is adhered to the housing 92) which serves as an outward adhesive surface of the self-adhesive electronic circuit. However, Isaacson fails to disclose or suggest a protective cover on the second adhesive surface which is removable to expose the second surface as an outward adhesive surface of the electronic circuit. In this respect, Isaacson certainly does not disclose or suggest that the housing 92 is removable to expose the second adhesive surface as an outward adhesive surface. Rather, Isaacson discloses that the housing 92 forms a rigid outer surface of the credit card-like structure (col. 10, line 9) which may be stamped with identifying indicia (col. 10, lines 10-12). Thus, Isaacson fails to meet the limitations of amended claim 1.

As a result, Applicant respectfully asserts that the rejection of claim 1 under 35 U.S.C. §102(e) over Isaacson should be withdrawn.

Each of claims 2-8 and 23-24 depends from claim 1 and is allowable for at least the same reasons.

B. Claims 16-23

As amended, claim 16 recites an electronic circuit, comprising a base having first and second surfaces; an antenna supported by the first surface of the base; a double-faced adhesive having first and second surfaces, the first surface of the double-faced adhesive being adhered to the first surface of the base, the second surface of the double-faced adhesive being covered with a protective cover, the double-faced adhesive having an opening, wherein at least a portion of the antenna is disposed in the opening; and an electronic chip disposed at least partially in the

opening and electrically coupled to the antenna; wherein the electronic chip is spaced from and does not contact the double-faced adhesive, and wherein the protective cover covering the second surface of the double-faced adhesive is removable to expose the second surface of the double-faced adhesive as an outward adhesive surface of the electronic circuit that enables the electronic circuit to be adhered to a non-planar surface.

As discussed above, Isaacson fails to disclose or suggest a self-adhesive electronic circuit which includes a double-faced adhesive having a first surface adhered to a base and a second surface covered by a protective cover which is removable to expose the second surface as an outward adhesive surface of the self-adhesive electronic circuit. As a result, claim 16 patentably distinguishes over Isaacson, such that the rejection of claim 16 under 35 U.S.C. §102(e) over Isaacson should be withdrawn.

Each of claims 17-22 depends from claim 16 and is allowable for at least the same reasons.

Rejections Under 35 U.S.C. §103(a)

Claims 9-11 and 14-15 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Isaacson in view of U.S. Patent No. 6,089,461 to Murohara ("Murohara"). Applicants respectfully traverse this rejection.

As amended, claim 9 recites an electronic circuit comprising a base having first and second surfaces; an antenna supported by the first surface of the base; a double-faced adhesive having first and second surfaces, the first surface of the double-faced adhesive being adhered to the first surface of the base, the second surface of the double-faced adhesive being covered with a protective cover, the double-faced adhesive having a thickness in a direction extending away from the first surface, the double-faced adhesive having an opening, wherein at least a portion of the antenna is disposed in the opening; and an electronic chip disposed at least partially in the opening and electrically coupled to the antenna, the electronic chip having a height in a direction extending away from the first surface; wherein the thickness of the double-faced adhesive is greater than or equal to the height of the electronic chip, and wherein the protective cover covering the second surface of the double-faced adhesive is removable to expose the second surface of the double-faced adhesive as an outward adhesive surface of the electronic circuit that enables the electronic circuit to be adhered to a non-planar surface.

The Office Action alleges that Isaacson discloses the limitations of claim 9 except for a double-faced adhesive having a thickness greater than or equal to the height of an electronic chip. The Office Action also asserts that Murohara discloses an electronic circuit including a double-faced adhesive which is thicker than the height of an electronic chip. The Office Action further asserts that one skilled in the art would have been motivated by Murohara to modify the structure of Isaacson to “improve the strength against bending and enhance the protection capability of the chip and/or antenna in the event the card is bended.”

Even assuming that a combination of Isaacson and Murohara is proper (which Applicants do not concede), the asserted combination fails to meet the limitations of amended claim 9. As discussed above, Isaacson fails to disclose or suggest a double-faced adhesive having a first surface adhered to a base and a second surface covered by a protective cover which is removable to expose the second surface as an outward adhesive surface of the self-adhesive electronic circuit. Murohara fails to remedy this deficiency, as Murohara makes no disclosure or suggestion of a protective cover covering a surface of a double-faced adhesive, and certainly not a protective cover which is removable to expose the surface as an outward adhesive surface of a self-adhesive electronic circuit.

For at least these reasons, the asserted combination of Isaacson and Murohara fails to meet the limitations of claim 9, such that claim 9 is not rendered obvious by the combination. Accordingly, Applicants respectfully assert that the rejection of claim 9 under 35 U.S.C. §103 should be withdrawn.

Each of claims 10-15 depends from claim 9 and is allowable for at least the same reasons.

#### New Claims


Claims 25-27 are provided to further clarify Applicant's contribution to the art. Specifically, claims 25, 26 and 27 depend from claims 1, 9 and 16, respectively, and define that the protective cover which is recited by each of claims 1, 9 and 16 comprises a film. As discussed above, each of claims 1, 9 and 16 distinguishes over the prior art of record. Applicants respectfully assert that claims 25-27 distinguish over the prior art of record for at least the same reasons.

**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,  
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